

Application No.: 10/689111

Case No.: 42698US059

REMARKS

Reexamination and reconsideration of the application is respectfully requested.

Claim 1 as previously submitted is considered to be nonobvious over the combination as proposed.

It is respectfully submitted that any rejection based on the combination of Kallenberg, Nealis and Rajala et al. may only be made by impermissible hindsight reconstruction, that is, by picking and choosing from each document that which supports these rejections. One cannot "simply [to] engage in a hindsight reconstruction of the claimed invention, using the Applicant's structure as a template and selecting elements from references to fill the gaps." In re Gorman, 933 F.2d 982, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991).

As recently reasserted in Princeton Biochemicals, Inc. v. Beckman Coulter, Inc. (Fed. Cir., No. 04-1493, June 9, 2005), 35 U.S.C. §103 specifically requires an assessment of the claimed invention "as a whole." This "as a whole" assessment of the invention requires a showing that an artisan of ordinary skill in the art at the time of invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention, would have selected the various elements from the cited references and combined them in the claimed manner. In other words, 35 U.S.C. §103 requires some suggestion or motivation, before the invention itself, to make the new combination. See In re Rouffet, 149 F.3d 1350, 1355-56 (Fed. Cir. 1998).

This "as a whole" instruction in 35 U.S. §103 prevents evaluation of the invention part by part. Without this important requirement, an obviousness assessment might successfully break an invention into its component parts, then find a reference corresponding to each component. This line of reasoning would import hindsight into the obviousness determination by using the invention as a roadmap to find its prior art components. Further, this improper method would discount the value of combining various existing features or principles in a new way to achieve a new result - often the essence of invention. Ruiz v. A.B. Chance Co., 357 F.3d 1270, 1275 (Fed. Cir. 2004). Simply identifying the various elements of a claim in the cited references does not render a claim obvious. Ruiz, 357 F.3d at 1275. Instead, 35 U.S. §103 requires some suggestion or motivation in the prior art to make the new combination. Rouffet, 149 F.3d at 1355-56.

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Applicants submit that the Examiner has engaged in an improper part by part analysis of the claimed produced, and, in particular, in making the current rejections based on picking out of context isolated elements of Kallenberg, in combination with Nealis and Rajala et al..

Kallenberg is from an entirely different art field than Nealis. Kallenberg is essentially a knitted product. Monofilaments are pressed into a backing. The backing would have to be of a strength and thickness to allow the monofilaments to be embedded into the backing. The exemplified backing in 0.03 inches (0.76 mm).

Nealis is an extrusion formed zipper. There is nothing that would suggest that this is at all related to any problem faced by Kallenberg and would result in an entirely different product than that of Kallenberg.

Rajala et al. is similar to Kallenberg, and alleges thinner backings could be used. However, this is with respect to a hook formed by thermal laminating fibers to a backing. Not integrally forming hook by an extrusion process which requires that the backing have a thickness to allow the hook elements to be withdrawn from the mold without tearing the backing.

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is requested.

Respectfully submitted,

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Date

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